APPENDIX

Reissue Statute

R. S. SEC. 4916. (U. S. C., title 35, sec. 64.) Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in the case of a machine

patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Disclaimer Statute

R. S. Sec. 4917. (U. S. C., title 35, sec. 65.) Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

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IN THE

Supreme Court of the United States

October Term, 1942

No. 243

GENERAL RADIO COMPANY,
Petitioner,

vs.

ALLEN B. DU MONT LABORATORIES, INC.,
Respondent.

MEMORANDUM FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

SAMUEL E. DARBY, JR.,
Counsel for Respondent.

FLOYD H. CREWS,
Of Counsel.

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MEMORANDUM FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is a patent infringement suit involving the ordinary issues of validity and infringement.

The reissue patent involved was held to be invalid by the Third Circuit Court of Appeals below. There has been no other adjudication of the patent by any other Circuit Court of Appeals. Therefore, there is no diversity of opinion between Circuit Courts of Appeals. Accordingly, the petition should be denied (*Keller* v. *Adams Campbell Co.*, 264 U. S. 314, 319; *Layne and Bowler Corp.* v. *Western Well Works*, 261 U. S. 387-393; *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 178-179).

The reissue patent in this case is an outstanding example of a most flagrant abuse of the reissue statute. The original patent (No. 1,707,594) issued on April 2, 1929. Application

for reissuance thereof was not filed until August 18, 1937—*nearly nine years later.*

The ground alleged for the reissue in the patentee's oath was:

> "(b) by reason of the patentee having claimed as his own invention or discovery, more than he had a right to claim as new, by including claims 1, 2, 3, 4, 5 and 6 of said original application and patent, which are in such terms that they may be construed to cover merely the function instead of the apparatus" (R. 122; see, also, opinion of the Court of Appeals, R. 319).

Obviously, as held by the Court of Appeals, this was not an "inadvertence, accident, or mistake" prescribed by the reissue statute as a condition to the grant of a valid reissue patent. To the contrary, it was the deliberate, considered action of skillful, competent attorneys. It is likewise as obvious, and was also pointed out by the Court of Appeals, that this alleged defect of the original patent *was apparent upon the face of the patent on the date of its grant on April 2, 1929,* and no excuse had been or could be offered for a delay of nearly nine years in discovering and correcting it.

In view of these circumstances, the petition unpardonably misconceives the issues decided by the Court of Appeals below in the futile effort to create a non-existent conflict with decisions of this Court and other Circuit Courts of Appeals. A mere reading of the two opinions (original opinion, R. 315, and on petition for rehearing R. 312) shows that factually they are based upon elementary principles announced years ago in decisions by this Court, and in no respect is there conflict between them.

Consequently, in the absence of diversity of opinion, this case is devoid of subject matter, novelty or grounds which would warrant review by this Court.

Respectfully submitted,

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IN THE

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COMMENT ON RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

DEAN S. EDMONDS,
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COMMENT ON RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The issuance of a writ of certiorari is invoked on the ground that the decision of the Court of Appeals in this case interpreting the reissue statute is in conflict with decisions of this Court and of the lower courts.

Respondent's counsel denies the existence of such conflict but does not support his denial and is unable to show that the conflict forming the basis of our petition does not exist.

Counsel does assert that the decision of the Court of Appeals is based "upon elementary principles announced years ago in decisions by this Court" (Memo. p. 2). But in our brief in support of the petition we pointed out that the Court of Appeals misapplied the elementary principles announced in *Dobson* v. *Lees*, 137 U. S. 258, and *Miller* v. *Brass Co.*, 104 U. S. 350 (Brief pp. 18, 24) and thus came into conflict with the decisions of this Court listed in the petition (pp. 8-10). Counsel offers no rebuttal.

Counsel refers to the action of the solicitor in drafting the original broad claims as "the deliberate, considered action of skillful, competent attorneys" (Memo. p. 2). Of course the action of a solicitor in drafting claims, in the absence of an accidental displacement of papers or a clerical error, is necessarily deliberate in the sense that it is a willful act. But it cannot be assumed as a matter of law that such an action is deliberate in the sense that it implies a consciousness of its ultimate consequences, and as this Court has held, where a solicitor, in seeking to draft claims as broadly as the law permits, submits claims improper in form either in consequence of a mistaken understanding of the law or by reason of an innocent misapplication of the law to the facts before him, this action, though willful, nevertheless constitutes a "mistake" within the meaning of the reissue statute.* (Petition pp. 12-21.) The Court of Appeals decision is in direct conflict.

Counsel also says that the defect corrected in the reissue was apparent on the face of the original patent. We agree in the sense that the functionality of claims 1 to 6 of the original patent and the effect of such functionality on the validity of these claims is a question of law to be determined from the face of the patent. But the action of the patent office in approving the form and legality of the claims precludes any conclusion, as a matter of law, that the invalidity of the claims is apparent in the sense of requiring immediate correction by the patentee before the action of the patent office has been reviewed by the Courts. This is the holding of this Court in the decisions referred to in support of our second point (Brief pp. 21-24) and

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*This situation is in contrast to that presented where the solicitor has deliberately submitted claims which he knows to be improper in the effort to overreach the Patent Office. But there is no evidence of any bad faith on the part of the solicitor here and the evidence in the case is all to the contrary (Petition pp. 4-6).

the Court of Appeals decision is in direct conflict. Nor is the invalidity of the claims apparent as a matter of law even though the questionable form of the claims appears on the face of the patent* (See our Point 3, Brief pp. 25-30).

Counsel characterizes the reissue as "an outstanding example of a most flagrant abuse of the reissue statute" (Memo. p. 1). Actually, as we have pointed out in our brief in support of the petition, the appropriateness of reissue, in a situation such as the present one, has received the full sanction of this Court and also of the lower courts in repeated decisions.

There are no special equities in the present case to call for a departure from the settled rule and counsel suggests none.

The decision of the Court of Appeals was reached by placing an interpretation on the reissue statute in conflict with that accorded it by this Court and the lower courts. It is to determine this conflict on an important point of patent law that a writ of certiorari is asked.

Respectfully submitted,

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.

Dated: New York, N. Y.,
September 18, 1942.

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*As a matter of fact the defect in the form of the claims was sufficiently subtle as to pass unnoticed even by present counsel for respondent until after the filing of the reissue. The history of the original patent is set forth in our Petition pages 4-6.